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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,218	09/12/2003	Juergen Pensel	33997.0089	9107
26712	7590	02/22/2006	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			SHIH, THEODORE C	
			ART UNIT	PAPER NUMBER
			3735	
DATE MAILED: 02/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/662,218	PENSEL ET AL.	
	Examiner	Art Unit	
	Theodore C. Shih	3735	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 September 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1/26/04 & 4/16/04

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites, "selected from the following group." The claim should recite "selected from the group consisting of" instead of "selected from the following group" to properly set forth a Markush group.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Koetke'952 (US Patent 5,760,952). Koetke'952 teaches a surgical microscope including an observing beam path that intersects with an object (patient's eye) (col. 3, lines 30-32) and an illuminating device which directs light onto a stationary mirror and movable mirror wherein variation of the relative position of mirrors 1a and 1b (Figure 2A) will alter the phase from light reflected off of mirror 1b (Figure 2A) thereby providing means to select the phase of the illuminating light (col. 4, lines 37-42).

Also, Koetke'952 teaches a surgical microscope where the illuminating device includes a light source (col.3, lines 37-38) used for testing red reflex (col.2, lines 8-10). It is generally known to one having ordinary skill in the art that red reflex tests involve a white light source (incoherent light source) and such a light source would have a characteristic illuminating light phase.

Furthermore, Koetke'952 teaches a surgical microscope where a displaceable diaphragm or light shield (col. 3, lines 54-55) can control the light illumination (producing certain optical properties).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fantone et al'154 (US Patent 4,786,154) in view of Koetke'952. Fantone et al.'154 teaches an enhanced-image operating microscope including a narrow band pass filter to each observation beam path to separate parts of the visible spectrum of interest (col. 2, lines 58-61); sensors (col. 2, lines 63-67); a pair of beam-splitters (first deflection element) which separate portions of the images provided by the magnification changer from the main optical path (col. 2, lines 53-57) and a pair of beam-combiners (second deflection element) which combine the enhanced images with

the visible images of the observation beam path (col. 4, lines 25-31); real time image processing devices (evaluation unit) (col. 3, lines 6-9); a pair of observation beam paths (col. 2, lines 45-49); displays (col. 4, lines 19-22) showing converted false-color images, gray-scale image (black-and-white image), and a true multi-color image (col. 3, lines, 43-51).

Fantone et al'154 indicates an illumination beam 13, but does not expressly teach an illumination device including means for selecting at least one of the spectral band, polarization, and phase of illuminating light. In the same field of endeavor Koetke'952 teaches a surgical microscope including an observing beam path that intersects with an object (patient's eye) (col. 3, lines 30-32) and an illuminating device which directs light onto a stationary mirror and movable mirror wherein variation of the relative position of mirrors 1a and 1b (Figure 2A) will alter the phase from light reflected off of mirror 1b (Figure 2A) thereby providing means to select the phase of the illuminating light (col. 4, lines 37-42). Also, Koetke'952 teaches a surgical microscope where the illuminating device includes a light source (col.3, lines 37-38) used for testing red reflex (col.2, lines 8-10). It is generally known to one having ordinary skill in the art that red reflex tests involve a white light source (incoherent light source) and such a light source would have a characteristic illuminating light phase. Furthermore, Koetke'952 teaches a surgical microscope where a displaceable diaphragm or light shield (col. 3, lines 54-55) can control the light illumination (producing certain optical properties). It would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the surgical microscope as taught by Fantone et

al'154 to incorporate the teachings of Koetke'952 by combining the illuminating device of the surgical microscope and the enhanced-image operating microscope since such a modification would allow a specific optical property of the illuminating light to illuminate the eye to be examined.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fantone et al'154 in view of Koetke'952 as applied to claim 2 above, and further in view of Nakamura'592 (US Patent Application Publication 2001/0010592).

Fantone et al'154 in view of Koetke'952 as applied to claim 2 above does not expressly teach a shutter in the observation path and a shutter between the display and the second deflection element. In the same field of endeavor Nakamura'592 teaches a stereomicroscope including a first shutter for selectively blocking a light flux from a target and a second shutter for selectively blocking a light flux from a monitor (col. 3, paragraph [0036]). It would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the surgical microscope as taught by Fantone et al'154 in view of Koetke'952 as applied to claim 2 above to incorporate the teachings of Nakamura'592 by combining the surgical microscope and the first shutter and second shutter in the stereomicroscope since such a modification would allow a user to selectively block a light flux from a target or a light flux from the monitor and to also provide an image of the target overlapped with an electronic image from the monitor when both shutters are open (col. 3, paragraph [0036] and paragraph [0037]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore C. Shih whose telephone number is (571) 272-7234. The examiner can normally be reached on 8:30-5:00 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ERIC F. WINAKUR  
PRIMARY EXAMINER